



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,223	10/06/2003	Dominique Canpont	022702-056	2021

21839 7590 02/14/2006

BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER


MOORE, MARGARET G

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/678,223	Applicant(s) CANPONT ET AL. 	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 to 34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12 to 34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. Claims 12 to 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, the language "comprising introducing a compatibilizer into the preparation mixture: after contacting of at least part of the silicone oil... ; or after this POS/filler contacting" is confusing. It appears that this claim requires that the compatibilizer to added to the mixture after the oil and at least some filler are mixed and that the final line of the claim is merely redundant, but clarification is required.

For claim 14, the difference between the first compatibilizer and at least one processing aid is unclear. It appears from the definition of the processing aid that this can be the same thing as a compatibilizer. This is true particularly since claim 13 limits the compatabilizer to silazane compounds and claim 15 indicates that the processing aid can be a silazane.

For claim 15, reference to "the processing aid" lacks antecedent basis.

For claim 17, note the confusion regarding the language in claim 12, as it applies to this claim as well.

Also since the suspension (A) includes POS fluids of the type (I) and optionally POS fluids of type (II), it is unclear if the POS fluids in (B) and (C) are the same ones mixed in (A) or are in addition to those found in (A).

Finally for claim 17, reference to "the particulate filler" on the top of page 5 of the amended claims lacks antecedent basis.

In claim 18, reference to the catalyst D is improper since claim 17 refers to the catalyst as component E.

2. The disclosure is objected to because of the following informalities: the specification should be amended to reflect the continuing status of this application as well as the status of the parent applications.

Appropriate correction is required.

Art Unit: 1712

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12 to 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Le Blanc et al.

Le Blanc et al. teach a method of extruding silicone dough suited for SiH/SiVi curing (i.e. the same cure system as in the instant claims). The four main components, silicone oil, water, silica and hexamethyldisilazane (herein HMDZ) are added in different zones along the extruder, with silicone oil being added the furthest “upstream”, followed by water, silica and then HMDZ, the latter added the further “downstream”. See column 3, lines 45 and on. This means that the silicone oil will first come into contact with water and silica followed by contact with HMDZ, which meets the compatibilizer in the claims, including the requirement of claim 13. As taught on the top of column 4, HMDZ can be added in two separate points designated HMDZ1 and HMDZ2. 35 to 70 wt% of the HMDZ is added as HMDZ1 and this corresponds to the claimed requirement of adding “in a first step” at most 8% compatibilizer with respect to the total filler.

For instance, attention is directed to Example 2. The amount of each of the four components falls within the ranges of claim 13. This does not show using at most 8% HMDZ per total filler. However, as noted on column 4 and in claim 5 of Le Blanc, 35% of the HMDZ can be added in this first step which corresponds to an amount of HMDZ that is less than 8 wt% based on the total silica. On the other hand, upon reading the teachings on column 4 of the amounts of each component taken in consideration with the specific disclosure of a first addition step of 35 wt%, this also corresponds to an amount of less than 8 wt% (35% of 3 parts HMDZ falls well within the range of less than 8 wt% of 20 to 80 parts silica).

Thus though the working examples do not show an example that meets the claimed weight requirement and Le Blanc does not specifically teach this requirement,

Art Unit: 1712

the amounts of each component taught by Le Blanc fall within this range such that the teachings in Le Blanc et al. anticipate the instant claims.

For claims 16 and 31 to 34, see column 3, lines 5 to 8 and line 64. Also note the silica particle size on column 3, line 25. For claims 17 and 18, note the teachings on the bottom of column 4. For claims 27 and 28, note that none of these components are actually required to be present in the claims.

5. Claims 12 to 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiki et al.

Fujiki et al. teach a process for preparing a liquid silicone composition. Particular attention is drawn to Examples 1 to 4 starting on the bottom of column 10. Note that a siloxane meeting the requirements of claims 20 and 29 to 32 is mixed with a silica powder meeting the specific surface area requirement of claim 16. This is followed by further addition of hexamethyldisilazane. In this manner the examples meets the claimed requirement of introducing a compatibilizer after contacting the silicone oil and filler. This example differs from the claim in that it uses more than 8 % compatibilizer per total filler.

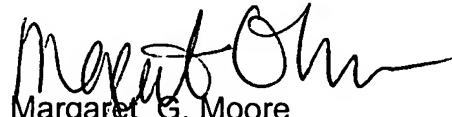
The total amounts of each component are found on column 2. As can be seen patentees specifically disclose levels of filler and silazane that meet the less than 8 % requirement. For instance the specifically disclosed (and thus anticipated) upper amount of filler and the specifically disclosed (and thus anticipated) lower amount of silazane corresponds to an amount of 1 wt% silazane. Thus, though the process used in the working examples does not anticipate the claims, this taken in combination with the totality of that taught by Fujiki et al. fully meets each of the claimed requirements.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Art Unit: 1712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
2/9/06